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END5293USNPRemarksStatus of Claims:

Claims 17, 18, and 20 were objected to. Claims 1-20 were rejected. Claims 1, 16, 17, 18, 19, and 20 have been amended.

The claims were amended in accordance with the amendments above. Claims 1, 16, and 19 have been amended to focus the claim on those aspects of the invention that are a commercial priority of the assignee. Claims 17, 18, and 20 have been amended to correct inadvertent formal errors. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

Claim Objections

In the Office Action dated 01/24/2006, claims 17, 18, and 20 were objected to for dependence informalities. In particular, claims 17 and 18 had previously depended from claim 19; while claim 20 had depended from claim 20. As observed by the Office, these dependence informalities were the result of inadvertent error by the Applicant. This error has been corrected by the amendments herein. In particular, claims 17 and 18 have been amended to each depend from claim 16, while claim 20 has been amended to depend from claim 19. Applicant therefore respectfully requests that the objections be withdrawn.

§ 102 Rejections:

Claims 1 and 6-8 were rejected under 35 U.S.C. §102(b) as being anticipated by Kumar et al. (U.S. Pub. No. 2003/0028094). Applicant respectfully traverses these rejections.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicant submits that Kumar et al. fails to anticipate independent claim 1.

Amended claim 1 recites a proximal needle segment and a distal needle segment that provide at least one substantially continuous lumen, wherein the proximal needle segment and the distal needle segment are longitudinally joined along a common axis. Kumar et al. fails to teach or suggest such limitations, among others, particularly in the arrangement required by claim 1. Accordingly, Applicant respectfully submits that Kumar et al. fails to anticipate

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amended claim 1 in accordance with MPEP 2131, and respectfully requests that the rejections be withdrawn.

Applicant further submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kumar et al. to obtain the invention that is presently claimed. In particular, Kumar et al. provides no motivation to provide a proximal needle segment and a distal needle segment that provide at least one substantially continuous lumen, wherein the proximal needle segment and the distal needle segment are longitudinally joined along a common axis. The invention presently claimed in claim 1 is therefore not obvious in view of Kumar et al. in accordance with MPEP 2143.01.

#### §103 Rejections

Claims 2-4 and 9-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar et al. in view of Huitema et al. (U.S. Pat. No. 6,626,849). Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar et al. in view of Sapatova et al. (U.S. Pub. No. 2003/0203140). Applicant respectfully traverses these rejections.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the amended claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each amended independent claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

With respect to claims 2-5 and 9-15, Applicant notes that, as discussed above with respect to the §102 rejection of independent claim 1, Kumar et al. fails to teach or suggest all

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of the limitations recited in claim 1. Applicant further submits that the other cited references, even in combination, fail to make up for this deficiency of Kumar et al. The combined art of record therefore fails to render independent claim 1 obvious in accordance with MPEP 2143.03. Because claims 2-5 and 9-15 include additional limitations relative to claim 1, the combined art of record also fails to render claims 2-5 and 9-15 obvious in accordance with MPEP 2143.03, and the rejections should therefore be withdrawn.

With respect to claims 16-18, Applicant notes that the combined art of record fails to teach or suggest all of the limitations recited in independent claim 16. In particular, the combined art of record fails to teach or suggest, among other things, a distal needle segment coupled with a proximal needle segment, wherein the distal cutter lumen portion of the distal needle segment is longitudinally coupled with the proximal cutter lumen portion of the proximal needle segment along a common axis. The combined art of record therefore fails to render independent claim 16 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

With respect to claims 19-20, Applicant notes that the combined art of record fails to teach or suggest all of the limitations recited in independent claim 19. In particular, the combined art of record fails to teach or suggest, among other things, the distal end of a proximal needle segment positioned distally of the proximal end of a distal needle segment. The combined art of record therefore fails to render independent claim 19 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczack*, 50 USPQ2d 1614 (Fed. Cir. 1999). Because the evidence of motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejection be withdrawn.

Beyond the foregoing shortcomings with respect to the rejections of the independent claim, Applicant further notes that the dependent claims include additional limitations not

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taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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